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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,602	11/17/2003	William P. Addiego	SP03-156	4882

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CORNING INCORPORATED  
SP-TI-3-1  
CORNING, NY 14831

EXAMINER
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NGUYEN, CAM N

ART UNIT	PAPER NUMBER
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1754

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/715,602

Applicant(s)

ADDIEGO ET AL.

Examiner

Cam N. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date originally filed.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### Claim Objections

1. Claims 1, 5, 7, & 9-10 are objected to because of the following informalities:
  - A. In claim 1, step (a), "homogenous" is suggested changed to --homogeneous--.
  - B. In claim 1, step (b), (c), & (d), it is suggested that applicants replace "preform" with --body--.
  - C. In claim 1, step (d), it is suggested applicants delete "suitable".
  - D. In claim 7, line 1, "claim 1wherein" should be changed to --claim 1 wherein--.
  - E. In claims 5 & 7, step (b), "spraying drying" should be changed to --spray drying--.
  - F. In claim 9, it is suggested that applicants replace "preform" with --body--.
  - G. In claim 10, line 1, it is suggested that applicants insert --support-- after "catalyst".

Appropriate correction is required.

### Claim Rejections - 35 USC § 112 (Second Paragraph)

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, line 2, the proper Markush terminology is --A, B, or C--. In

this case, --gamma-alumina, boehmite, pseudo-boehmite, *or mixtures thereof*--.

**Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaffe (US Pat. 4,289,653).

Jaffe discloses an extruded silica-alumina catalyst which prepared by the method which consists essentially of the following steps: mixing a sodium silicate solution with an aqueous aluminum sulfate solution and sulfuric acid to form an acidified silica sol in an alumina salt solution having a pH in the range of about 1 to 3; adding sufficient ammonium hydroxide to said acidified silica sol in the aluminum salt solution to form a cogelled mass of silica and alumina under substantially constant pH conditions and at a pH of at least 4; adding additional ammonium hydroxide to the cogelled mass to obtain a pH in the range of 7.5 to 8.5; washing the cogelled mass; mulling the cogelled mass with a peptizing agent, a Group VI-B metal compound and a Group VIII metal compound to form an extrudable dough; extruding said dough; and drying and calcining the extruded dough (see col. 6, claim 1). The peptizing agent is acetic acid (see col. 6, claim 3). The method further comprising spray-drying the washed cogelled mass prior to the mulling step (see col. 6, claim 4). The extrudates are dried at a temperature of up

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to 200°C for a period of several hours, and calcined in an oxidizing atmosphere, such as air, at a temperature of from about 315°C to about 650°C over a period of from about 0.5 to about 6 hours (see col. 4, ln 34-41). Jaffe further discloses catalysts A-F which were prepared by using the weight ratio of alumina to silica in the amount of 75/25 to 70/30 (see Table I in Examples).

Regarding claim 1, step (a), Jaffe is silent with respect to the amount of the acid contains in the mixture (or in the amount of at least 0.25% by weight) as being claimed. It would have been *prima facie obvious* to one of ordinary skill in the art at the time the invention was made to have predetermined the optimum amount of the acid in such process because it is a result effective variable, in view of *In re Boesch*.

Regarding claim 1, step (d) & claim 10, it is considered *prima facie obvious* to one of ordinary skill in the art that the surface area of the disclosed support material would be the same as the claimed support because the same support material is disclosed and being claimed by applicants.

Regarding claims 2-3, 5, & 7, it is considered the specific alumina source being claimed, and the order of addition of the alumina source and the silicon source is not seen to result in a support material having structurally difference per se since the aluminum compound and silicon compound would decompose into an oxide upon heating or calcining.

Regarding claims 4, 6, & 8, the disclosed pH range falls within the claimed pH range, thus meets the claims.

**Citations**

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All references are cited for related art. See PTO-892 Form prepared attached.

**Conclusion**

7. Claims 1-10 are pending. Claims 1-10 are rejected. No claims are allowed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cam N Nguyen, whose telephone number is 571-272-1357. The examiner can normally be reached on M, W, R, & F, 9:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nguyen/cnn *cnn*  
September 27, 2005

*Cam Nguyen*  
CAM N. NGUYEN  
PRIMARY EXAMINER

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